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David Benjamin Auerbach

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GOOGLE / FENWICK

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EXAMINER

HICKS, MICHAEL J

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,052

Applicant(s)

AUERBACH ET AL.

Examiner

Michael J. Hicks

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8,11-47,49-51,54 and 57-109 is/are pending in the application.
4a) Of the above claim(s) 26-46 and 62-72 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3-5,8,11-25,49-51,54,57-61 and 73-109 is/are rejected.
7) ☒ Claim(s) 104, 106 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 3-5, 8, 11-47, 49-51, 54, and 57-109 Pending
Claims 26-46 and 62-72 Withdrawn.
Claims 2, 6-7, 9-10, 48, 52-53, and 55-56 Canceled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/9/2008 has been entered.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 3-5, 8, 11-47, 49-51, 54, and 57-109 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claims 104 and 106 objected to because of the following informalities:
Claim 104 is an exact copy of Claim 101.
Claim 106 is an exact copy of Claim 105.
Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-5, 8, 11, 16-24, 47, 49-51, 54, 57, 73-77, 83-88, 91-92, 101, and 104-106 rejected under 35 U.S.C. 103(a) as being unpatentable over Tripp in view of Mathur and further in view of Brandli.

As per Claims 1 and 47, Tripp discloses a method comprising: generating a user context-dependent search query (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that because the user input the query, the query is user context-dependant.) (Column 3, Lines 21-38); responsive to identifying an aspect associated with an article (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired*

information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine." The preceding text excerpt clearly indicates that before the search is performed, an aspect associated with an article (e.g. file) must be indicated. Note that an aspect may be any information associate with the file, and that the invention, as claimed, does not indicate any automation or computer involvement in identifying the aspect, thus a user searching for known files on the users computer meets the limitation.) (Column 3, Lines 21-38); generating an insert based, at least in part, on the aspect, wherein the insert comprises a search result (i.e. *"Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that searching is provided, e.g. an insert in the form of a search result is created.) (Column 3, Lines 32-38) associated with the aspect and generated responsive, at least in part, to searching an article index using the user-context dependant search query (i.e. *"Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt along with the above disclosure clearly indicates that generating the insert (e.g. search result) associated with the aspect comprises searching an article/file index using the previously generated user-context dependant search query.) (Column 3, Lines 32-38).

Tripp fails to disclose causing the insert to be output in association with the aspect and the user context-dependent search query is based, at least in part, on a

user action history comprising a plurality of user actions were performed on a plurality of articles.

Mathur discloses causing the insert to be displayed in a transient window proximate to the aspect (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user."* The preceding text excerpt clearly indicates that the insert (e.g. search result) is displayed in a pop-up window proximate to the aspect. Examiner notes that as a pop-up window may be closed, it is considered to be transient and that the pop up window may overlap the aspect and thereby be considered to be proximate to the aspect.) (Page 1) and the user context-dependent search query is based, at least in part, on a user action history comprising a plurality of user actions associated with a plurality of articles (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents*

identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user. " The preceding text excerpt clearly indicates that the user context-dependant search query will be based on a user action history based on user interactions with a plurality of browsed documents.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include causing the insert to be displayed in a transient window proximate to the aspect and the user context-dependent search query is based, at least in part, on a user action history comprising a plurality of user actions associated with a plurality of articles with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

Tripp and Mathur fail to disclose that the user action history includes a plurality of dates upon which the user actions were performed.

Brandli discloses that the user action history includes a plurality of dates upon which the user actions were performed (i.e. *"Consider, for example, document 321 and document 323, which both contain the term "A." Node 307 in the directory structure 304 contains an entry for the indexing term "A." This entry points to leaf structure 309, which contains references to two documents labeled "1" and "3." In the particular implementation shown, the leaf structures 309-312 point to a centralized list of documents for the entire content-index (object list 303) to avoid storing large or redundant amounts of information in the leaf structures themselves. Thus, the references to a document "1" and a document "3" in the leaf structure 309 indicate which documents in the object list 303 contain the indexing term. Specifically, leaf structure 309 indicates that the document referred to by the first entry 315 in object list 303 contains indexing term "A" and that the document referred to by the third entry 317*

in object list 303 also contains the indexing term "A." The object list 303 also contains additional information regarding each object (document) that is indexed by the inverted list 302. As shown, object list 303 contains in each entry the name of the object, the location of the object, and a timestamp indicating the last time the object was updated. By examining the referred to entries in object list 303, the names and locations of the documents containing the indexing term "A" can be retrieved. Thus, the first entry 315 refers to the document "doc1.txt" 321 and the third entry 317 refers to the document "doc5.x1s," both of which contain the term "A." The preceding text excerpt clearly indicates that the user action history may include timestamps representing when user actions were performed on the plurality of documents.) (Figure 3; Column 6, Lines 49-67; Column 7, Lines 1-8).

It would have been obvious to one skilled in the art at the time of Applicants invention to modify the teachings of Tripp and Mathur with the teachings of Brandli to include that the user action history includes a plurality of dates upon which the user actions were performed with the motivation of generating accurate search results using a content-index (Brandli, Abstract).

As per Claims 3 and 49, Tripp discloses the article index comprises an index of articles available on the World Wide Web (i.e. *"Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that file index may include files/article available on the world wide web.) (Column 3, Lines 32-38).

As per Claims 4 and 50, Tripp discloses the article index comprises a local article index (i.e. *"Discovery, and generates a local index of files on a user's personal computer much like the*

central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine." The preceding text excerpt clearly indicates that the article/file index may be an index of local articles/files.) (Column 3, Lines 32-38).

As per Claims 5 and 51, Tripp discloses the local article index comprises a messaging index (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article index may include email messages (e.g. a messaging index).) (Column 3, Lines 49-53).

As per Claims 8 and 54, Tripp fails to disclose the search result comprises at least one of an article identifier, a thumbnail, a text snippet, a Uniform Resource Locator, and a path

Mathur discloses the search result comprises at least one of an article identifier, a thumbnail, a text snippet, a Uniform Resource Locator, and a path (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to*

documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user." The preceding text excerpt clearly indicates that the search result may comprise a text snippet, URL, or path (e.g. link.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a window separate from the article with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claims 11 and 57, Tripp Fails to disclose causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a window separate from the article.

Mathur discloses causing the insert to be displayed in a transient window proximate to the aspect comprises causing the display of at least part of the insert in a pop-up window proximate to the aspect (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest*

to the user based on the contents of the documents presently viewed by the user." The preceding text excerpt clearly indicates that the insert (e.g. search result) is displayed in a pop-up window proximate to the aspect. Examiner notes that as a pop-up window may be closed, it is considered to be transient and that the pop up window may overlap the aspect and thereby be considered to be proximate to the aspect.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include causing the insert to be displayed in a transient window proximate to the aspect comprises causing the display of at least part of the insert in a pop-up window proximate to the aspect with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claim 16, Tripp discloses the aspect comprises a hyperlink (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, a hyperlink in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claim 17, Tripp discloses the aspect comprises a title (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the*

Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine." The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, a title of/in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claim 18, Tripp discloses the aspect comprises an image (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, an image in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claim 19, Tripp discloses the aspect comprises a menu item (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet*

searches using the central index of the AltaVista.RTM. search engine." The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, a menu item in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claim 20, Tripp discloses the aspect comprises an input field (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, an input field in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claim 21, Tripp discloses the article comprises a web page (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article may comprise a HTML document/web page/Netscape file.) (Column 3, Lines 49-53).

As per Claim 22, Tripp discloses the article comprises a text document (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article may comprise a text/Office document.) (Column 3, Lines 49-53).

As per Claims 23, Tripp discloses the article comprises an email message (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article may comprise an email message/Eudora file.) (Column 3, Lines 49-53).

As per Claims 24, Tripp discloses the article comprises an instant messenger message (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article may comprise an instant messenger message (e.g. the instant messenger message could be in the form of a chat log (e.g. text document) or in the form of an email message.) (Column 3, Lines 49-53).

As per Claims 73 and 83, Tripp fails to disclose the user-context-dependent search query is further based on a client application a user is executing.

Mathur discloses the user-context-dependent search query is further based on a client application a user is executing (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's*

computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user." The preceding text excerpt clearly indicates that the context dependent search query is implicitly based on a client application the user is executing (e.g. the web browser used to view the page.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include the user-context-dependent search query is further based on a client application a user is executing with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claims 74 and 84, Tripp fails to disclose the user-context-dependent search query is further based on a file upon which a user is performing an operation.

Mathur discloses the user-context-dependent search query is further based on a file upon which a user is performing an operation (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user."* The preceding text excerpt clearly indicates that the context dependent search query is based on

the web page (e.g. html file) which the user is browsing (e.g. has performed the action of opening.)
(Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include the user-context-dependent search query is further based on a file upon which a user is performing an operation with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claims 75-77 and 85-87, the limitations of an action of the plurality of user actions is opening a file, an action of the plurality of user actions is printing a file, and an action of the plurality of user actions is sending an email message are considered to be non-functional descriptive material and are given no patentable weight as the nature of the user action has no effect on how the implicit search query is built, only it's subject matter.

From the MPEP:

If the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine, Office personnel must determine whether the descriptive material is functional descriptive material or nonfunctional descriptive material, as described supra in paragraphs IV.B.1(a) and IV. B.1(b). Functional descriptive material is a limitation in the claim and must be considered and addressed in assessing patentability under 35 U.S.C. 103. Thus, a rejection of the claim as a whole under 35 U.S.C. 103 is inappropriate unless the functional descriptive material would have been suggested by the prior art. In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. In re Ngai, ***367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (combining printed instructions and an old product into a kit will not render the claimed invention nonobvious even if the instructions detail a new use for the product).< Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are: - a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or -

a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

As per Claims 88, 101, and 104, Tripp fails to disclose causing the insert to be output in a transient window proximate to the aspect comprises causing a display of at least part of the insert in a drop-down window proximate to the aspect.

Mathur discloses causing the insert to be output in a transient window proximate to the aspect comprises causing a display of at least part of the insert in a drop-down window proximate to the aspect (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user."* The preceding text excerpt clearly indicates that the insert (e.g. search result) is displayed in a pop-up (e.g. drop down) window proximate to the aspect. Examiner notes that as a pop-up window may be closed, it is considered to be transient and that the pop up window may overlap the aspect and thereby be considered to be proximate to the aspect.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include causing the insert to be output in a transient window proximate to the aspect comprises causing a display of at least part of the insert in a drop-down window proximate to the aspect with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claims 91, 105 and 106, Tripp fails to disclose causing the insert to be displayed in a transient window proximate to the aspect comprises causing the insert to be displayed above the aspect.

Mathur discloses causing the insert to be displayed in a transient window proximate to the aspect comprises causing the insert to be displayed above the aspect (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user."* The preceding text excerpt clearly indicates that the insert (e.g. search result) is displayed in a pop-up (e.g. drop down) window proximate to the aspect. Examiner notes

that as a pop-up window may be closed, it is considered to be transient and that the pop up window may be displayed above the aspect.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include causing the insert to be displayed in a transient window proximate to the aspect comprises causing the insert to be displayed above the aspect with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claim 92 Tripp fails to disclose causing the insert to be displayed in a transient window proximate to the aspect comprises causing the insert to be displayed below the aspect.

Mathur discloses causing the insert to be displayed in a transient window proximate to the aspect comprises causing the insert to be displayed below the aspect (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user."* The preceding text excerpt clearly indicates that the insert (e.g.

search result) is displayed in a pop-up (e.g. drop down) window proximate to the aspect. Examiner notes that as a pop-up window may be closed, it is considered to be transient and that the pop up window may be displayed below the aspect.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include causing the insert to be displayed in a transient window proximate to the aspect comprises causing the insert to be displayed below the aspect with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

7. Claims 12-15 and 58-61 rejected under 35 U.S.C. 103(a) as being unpatentable over Tripp in view of Mathur further in view of Brandli, as above, and in further view of Phelps ("All you can seek", Special Services, July 1999, Vol.7, Iss. 7, accessed on the web on 10/16/2006 at <http://www.smartcomputing.com/editorial/article.asp?article=articles/archive/g0707/26g07/26g07.asp>)..

As per Claims 12 and 58, Tripp-Mathur-Brandli fails to disclose at least one of identifying the aspect, generating the insert, and causing the insert to be output in association with the aspect is based, at least in part, on a user preference.

Mathur discloses at least one of identifying the aspect, generating the insert, and causing the insert to be output in association with the aspect is based, at least in part, on a user preference (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file.*

That's the kind of bargain we like the best." The preceding text excerpt clearly indicates that generating the insert (e.g. producing the search result) is based on user preferences in the form of search preferences.) (Page 5, Paragraph 8, Page 6, Paragraph 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp-Mathur-Brandli with the teachings of Phelps to include at least one of identifying the aspect, generating the insert, and causing the insert to be output in association with the aspect is based, at least in part, on a user preference with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 13 and 59, Tripp-Mathur-Brandli fails to disclose receiving the user preference.

Phelps discloses receiving the user preference (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file. That's the kind of bargain we like the best."* The preceding text excerpt clearly indicates that the user may input the preferences (e.g. the preferences will be received).) (Page 5, Paragraph 8, Page 6, Paragraph 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp-Mathur-Brandli with the teachings of Phelps to include receiving the user preference with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 14 and 60, Tripp-Mathur-Brandli fails to disclose determining the user preference based, at least in part, on a user action history comprising a plurality of user actions.

Phelps discloses determining the user preference based, at least in part, on a user action history comprising a plurality of user actions (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file. That's the kind of bargain we like the best."* The preceding text excerpt clearly indicates that the user preferences are based on a user action history comprising a plurality of user actions (e.g. the user setting the preferences).) (Page 5, Paragraph 8, Page 6, Paragraph 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp-Mathur-Brandli with the teachings of Phelps to include determining the user preference based, at least in part, on a user action history comprising a plurality of user actions with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 15 and 61, Tripp-Mathur-Brandli fails to disclose determining the user preference based, at least in part, on a system analysis.

Phelps discloses determining the user preference based, at least in part, on a system analysis (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file. That's the kind of bargain we like the best."* The preceding text excerpt clearly indicates that after the user preferences

have been set, the preferences will be determined for searching purposes by scanning the system to identify which user preferences the user has selected.) (Page 5, Paragraph 8, Page 6, Paragraph 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp-Mathur-Brandli with the teachings of Phelps to include determining the user preference based, at least in part, on a system analysis with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

8. Claims 25, 78-82, and 99-100 rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrove et al. in view of Mathur and further in view of Brandli.

As per Claim 25, Musgrove discloses a method comprising: identifying an aspect associated with an article (i.e. *"...determining word scores of the words in the document based on the frequency of the words in the document, adjusting the word scores of the words by predetermined weightings corresponding to the use of each word in the document, constructing a keyword query search string using words having the highest word scores..."* The preceding text excerpt clearly indicates that an aspect associated with an article (e.g. keywords in a web page) are identified.) (Page 2, Paragraph 16); automatically searching a local article index with a user context-dependent search query for a search result associated with the aspect (i.e. *"...searching the product records of the products database to identify products satisfying the keyword query search string, assigning product scores to the identified products based on matches to the keyword query search string, parsing the product records to identify word matches in each of the product records and the document, updating the product score by processing the adjusted word scores corresponding to the matched word with the product score of the product for which word matched, and selecting products from the identified products that have the highest updated product scores..."* The preceding text excerpt clearly indicates that a local

article index (e.g. product database) is automatically searched with the a query associated with the aspect. Note that as the user requested the search be done (paragraph 26), the query is user context-dependant.) (Page 2, Paragraph 16); automatically generating an insert comprising an image representing the search result (i.e. *"The re-sorted list of products is provided to the display module 28 that sends the results to the client 40 for display as advertisements or links, or in other format as being products that the user may want to consider."* The preceding text excerpt clearly indicates that the insert (e.g. query result) may be inserted into the article as an advertisement (e.g. image representing the search result.) (Page 9, Paragraph 62); and causing the article to be displayed (i.e. *"The re-sorted list of products is provided to the display module 28 that sends the results to the client 40 for display as advertisements or links, or in other format as being products that the user may want to consider."* The preceding text excerpt clearly indicates that the article (e.g. web page) may be displayed.) (Page 9, Paragraph 62).

Musgrove fails to disclose the user context dependent search query is based, at least in part, on a user action history comprising a plurality of user actions performed on a plurality of articles, and placing the insert into the article such that the insert will be displayed near the aspect when the article is displayed.

Mathur discloses the user context dependent search query is based, at least in part, on a user action history comprising a plurality of user actions performed on a plurality of articles (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented*

to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user." The preceding text excerpt clearly indicates that the user context dependent search query (e.g. implicit query) is based on a user action history comprising a plurality of user action performed on a plurality of document (e.g. the history of user interaction within searched documents).) (Page 1) and placing the insert into the article such that the insert will be displayed proximate to the aspect when the article is displayed (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user."* The preceding text excerpt clearly indicates that the insert (e.g. search result) is displayed in a pop-up window proximate to the aspect. Examiner notes that the pop up window may overlap the aspect and thereby be considered to be proximate to the aspect.) (Page 1).

It would have been obvious to one skilled in the art at the time of Applicants invention to modify the teachings of Musgrove with the teachings of Mathur to include the user context dependent search query is based, at least in part, on a user action history comprising a plurality of user actions performed on a plurality of articles and

placing the insert into the article such that the insert will be displayed near the aspect when the article is displayed with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

Musgrove and Mathur fail to disclose that the user action history includes a plurality of dates upon which the user actions were performed.

Brandli discloses that the user action history includes a plurality of dates upon which the user actions were performed (i.e. "Consider, for example, document 321 and document 323, which both contain the term "A." Node 307 in the directory structure 304 contains an entry for the indexing term "A." This entry points to leaf structure 309, which contains references to two documents labeled "1" and "3." In the particular implementation shown, the leaf structures 309-312 point to a centralized list of documents for the entire content-index (object list 303) to avoid storing large or redundant amounts of information in the leaf structures themselves. Thus, the references to a document "1" and a document "3" in the leaf structure 309 indicate which documents in the object list 303 contain the indexing term. Specifically, leaf structure 309 indicates that the document referred to by the first entry 315 in object list 303 contains indexing term "A" and that the document referred to by the third entry 317 in object list 303 also contains the indexing term "A." The object list 303 also contains additional information regarding each object (document) that is indexed by the inverted list 302. As shown, object list 303 contains in each entry the name of the object, the location of the object, and a timestamp indicating the last time the object was updated. By examining the referred to entries in object list 303, the names and locations of the documents containing the indexing term "A" can be retrieved. Thus, the first entry 315 refers to the document "doc1.txt" 321 and the third entry 317 refers to the document "doc5.x1s," both of which contain the term "A."" The preceding text excerpt clearly indicates that the user action history may include timestamps representing when user actions were performed on the plurality of documents.) (Figure 3; Column 6, Lines 49-67; Column 7, Lines 1-8).

It would have been obvious to one skilled in the art at the time of Applicants invention to modify the teachings of Musgrove and Mathur with the teachings of Brandli to include that the user action history includes a plurality of dates upon which the user actions were performed with the motivation of generating accurate search results using a content-index (Brandli, Abstract).

As per Claims 78, Musgrove fails to disclose the user-context-dependent search query is further based on a client application a user is executing.

Mathur discloses the user-context-dependent search query is further based on a client application a user is executing (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user."* The preceding text excerpt clearly indicates that the context dependent search query is implicitly based on a client application the user is executing (e.g. the web browser used to view the page).) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Musgrove with the teachings of Mathur to include the user-context-dependent search

query is further based on a client application a user is executing with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claims 79, Musgrove fails to disclose the user-context-dependent search query is further based on a file upon which a user is performing an operation.

Mathur discloses the user-context-dependent search query is further based on a file upon which a user is performing an operation (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user."* The preceding text excerpt clearly indicates that the context dependent search query is based on the web page (e.g. html file) which the user is browsing (e.g. has performed the action of opening). (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Musgrove with the teachings of Mathur to include the user-context-dependent search query is further based on a file upon which a user is performing an operation with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claims 80-82, the limitations of an action of the plurality of user actions is opening a file, an action of the plurality of user actions is printing a file, and an action of the plurality of user actions is sending an email message are considered to be non-functional descriptive material and are given no patentable weight as the nature of the user action has no effect on how the implicit search query is built, only it's subject matter.

From the MPEP:

If the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine, Office personnel must determine whether the descriptive material is functional descriptive material or nonfunctional descriptive material, as described supra in paragraphs IV.B.1(a) and IV. B.1(b). Functional descriptive material is a limitation in the claim and must be considered and addressed in assessing patentability under 35 U.S.C. 103. Thus, a rejection of the claim as a whole under 35 U.S.C. 103 is inappropriate unless the functional descriptive material would have been suggested by the prior art. In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. In re Ngai, **>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (combining printed instructions and an old product into a kit will not render the claimed invention nonobvious even if the instructions detail a new use for the product).< Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are: - a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

As per Claim 99, Musgrove fails to disclose causing the insert to be displayed proximate to the aspect comprises causing the insert to be displayed above the aspect.

Mathur discloses causing the insert to be displayed proximate to the aspect comprises causing the insert to be displayed above the aspect (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user."* The preceding text excerpt clearly indicates that the insert (e.g. search result) is displayed in a pop-up (e.g. drop down) window proximate to the aspect. Examiner notes that as a pop-up window may be closed, it is considered to be transient and that the pop up window may be displayed above the aspect.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Musgrove with the teachings of Mathur to include causing the insert to be displayed proximate to the aspect comprises causing the insert to be displayed above the aspect with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claim 99, Musgrove fails to disclose causing the insert to be displayed proximate to the aspect comprises causing the insert to be displayed below the aspect.

Mathur discloses causing the insert to be displayed proximate to the aspect comprises causing the insert to be displayed below the aspect (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user."*) The preceding text excerpt clearly indicates that the insert (e.g. search result) is displayed in a pop-up (e.g. drop down) window proximate to the aspect. Examiner notes that as a pop-up window may be closed, it is considered to be transient and that the pop up window may be displayed below the aspect.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Musgrove with the teachings of Mathur to include causing the insert to be displayed proximate to the aspect comprises causing the insert to be displayed below the aspect with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

9. Claims 89-90, and 102-103 rejected under 35 U.S.C. 103(a) as being unpatentable over Tripp in view of Mathur in view of Brandli, and further in view of Morrison et al. (U.S. Patent Number 6,803,906 and referred to hereinafter as Morrison).

As per Claims 89 and 102, Tripp in view of Mathur in view of Brandli fails to disclose causing the insert to be displayed in a transient window proximate to the aspect comprises: receiving a signal that indicates that a user has clicked on the aspect; and causing the insert to be output in the transient window proximate to the aspect responsive to the signal.

Morrison discloses causing the insert to be displayed in a transient window proximate to the aspect comprises: receiving a signal that indicates that a user has clicked on the aspect; and causing the insert to be output in the transient window proximate to the aspect responsive to the signal (i.e. *"On the other hand, high-resolution passive touch screens have sufficient DPI to detect contacts that are proportional to a small number of pixels or sub-pixels of the computer or video display. However, a requirement for high-resolution touch screens is the ability to detect when the pointer is in contact with the touch surface. This is necessary for writing, drawing, mouse-click operations, etc. Without the ability to detect pointer contact with the touch screen, writing and drawing would be one continuous operation, and mouse clicks would not be possible thereby making computer display manipulation impossible. A secondary requirement is the ability to detect when the pointer is "hovering" above the touch surface. Although not required for writing or drawing, today's computer operating systems are increasingly using hover information to manipulate computer or video displays or pop-up information boxes."* The preceding text excerpt clearly indicates that pop-up information boxes may be displayed responsive to a mouse click signal.) (Column 2, Lines 6-21).

It would have been obvious to one skilled in the art to modify the teachings of Tripp in view of Mathur in view of Brandli with the teachings of Morrison to include causing the insert to be displayed in a transient window proximate to the aspect comprises: receiving a signal that indicates that a user has clicked on the aspect; and

causing the insert to be output in the transient window proximate to the aspect responsive to the signal with the motivation of increasing the input capabilities of modern computing systems (Morrison, Column 2, Lines 6-21).

As per Claims 90 and 103, Tripp in view of Mathur in view of Brandli fails to disclose causing the insert to be displayed in a transient window proximate to the aspect comprises: receiving a signal that indicates that a pointer controlled by a pointing device is hovering over the aspect; and causing the insert to be output in the transient menu proximate to the aspect responsive to the signal.

Morrison discloses causing the insert to be displayed in a transient window proximate to the aspect comprises: receiving a signal that indicates that a pointer controlled by a pointing device is hovering over the aspect; and causing the insert to be output in the transient menu proximate to the aspect responsive to the signal (i.e. *"On the other hand, high-resolution passive touch screens have sufficient DPI to detect contacts that are proportional to a small number of pixels or sub-pixels of the computer or video display. However, a requirement for high-resolution touch screens is the ability to detect when the pointer is in contact with the touch surface. This is necessary for writing, drawing, mouse-click operations, etc. Without the ability to detect pointer contact with the touch screen, writing and drawing would be one continuous operation, and mouse clicks would not be possible thereby making computer display manipulation impossible. A secondary requirement is the ability to detect when the pointer is "hovering" above the touch surface. Although not required for writing or drawing, today's computer operating systems are increasingly using hover information to manipulate computer or video displays or pop-up information boxes."* The preceding text excerpt clearly indicates that pop-up information boxes may be displayed responsive to a mouse hovering signal.) (Column 2, Lines 6-21).

It would have been obvious to one skilled in the art to modify the teachings of Tripp in view of Mathur in view of Brandli with the teachings of Morrison to include causing the insert to be displayed in a transient window proximate to the aspect comprises: receiving a signal that indicates that a pointer controlled by a pointing device is hovering over the aspect; and causing the insert to be output in the transient menu proximate to the aspect responsive to the signal with the motivation of increasing the input capabilities of modern computing systems (Morrison, Column 2, Lines 6-21).

10. Claims 93-95, and 107-109 rejected under 35 U.S.C. 103(a) as being unpatentable over Tripp in view of Mathur in view of Brandli, and further in view of Cantrell (U.S. Pre Grant Publication Number 2002/0103698).

As per Claims 93 and 107, Tripp in view of Mathur in view of Brandli fail to disclose the insert comprises a request for a user to perform an action.

Cantrell discloses the insert comprises a request for a user to perform an action (i.e. *"As can be appreciated, additional types of "click action" can be defined. In one example, sales-oriented ad objectives would include a click action screen that enabled the advertiser to specify an online coupon for a discount on the advertised service or offering. Upon a click onto the online ad, the online coupon would be displayed in a pop-up window that would enable the user to print the online coupon. In one embodiment, the click action screen would prompt the user for the content of the coupon (e.g., value of the coupon). This content data would be used to generate an online coupon that was consistent in style and presentation with the generated online ad."* The preceding text excerpt clearly indicates that pop-up information boxes may include a request for user action (e.g. prompt the user for content). (Paragraph 139).

It would have been obvious to one skilled in the art to modify the teachings of Tripp in view of Mathur in view of Brandli with the teachings of Cantrell to include the insert comprises a request for a user to perform an action with the motivation of defining additional types of 'click action' for online interaction (Cantrell, Paragraph 139).

As per Claims 94 and 108, Tripp in view of Mathur in view of Brandli fail to disclose the action to be performed by the user is an action to be performed on the article.

Cantrell discloses the action to be performed by the user is an action to be performed on the article (i.e. *"As can be appreciated, additional types of "click action" can be defined. In one example, sales-oriented ad objectives would include a click action screen that enabled the advertiser to specify an online coupon for a discount on the advertised service or offering. Upon a click onto the online ad, the online coupon would be displayed in a pop-up window that would enable the user to print the online coupon. In one embodiment, the click action screen would prompt the user for the content of the coupon (e.g., value of the coupon). This content data would be used to generate an online coupon that was consistent in style and presentation with the generated online ad."* The preceding text excerpt clearly indicates that pop-up information boxes may include a request for user action (e.g. prompt the user for content).) (Paragraph 139).

It would have been obvious to one skilled in the art to modify the teachings of Tripp in view of Mathur in view of Brandli with the teachings of Cantrell to include the action to be performed by the user is an action to be performed on the article with the motivation of defining additional types of 'click action' for online interaction (Cantrell, Paragraph 139).

As per Claims 95 and 109, Tripp in view of Mathur in view of Brandli fail to disclose the action to be performed by the user is to provide an instruction related to the article.

Cantrell discloses the action to be performed by the user is to provide an instruction related to the article (i.e. *"As can be appreciated, additional types of "click action" can be defined. In one example, sales-oriented ad objectives would include a click action screen that enabled the advertiser to specify an online coupon for a discount on the advertised service or offering. Upon a click onto the online ad, the online coupon would be displayed in a pop-up window that would enable the user to print the online coupon. In one embodiment, the click action screen would prompt the user for the content of the coupon (e.g., value of the coupon). This content data would be used to generate an online coupon that was consistent in style and presentation with the generated online ad."* The preceding text excerpt clearly indicates that pop-up information boxes may include instruction related to the article (e.g. prompt the user for content based on instruction).) (Paragraph 139).

It would have been obvious to one skilled in the art to modify the teachings of Tripp in view of Mathur in view of Brandli with the teachings of Cantrell to include the action to be performed by the user is to provide an instruction related to the article with the motivation of defining additional types of 'click action' for online interaction (Cantrell, Paragraph 139).

11. Claims 96-98 rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrove in view of Mathur in view of Brandli and further in view of Cantrell.

As per Claims 96, Musgrove in view of Mathur in view of Brandli fail to disclose the insert comprises a request for a user to perform an action.

Cantrell discloses the insert comprises a request for a user to perform an action (i.e. "As can be appreciated, additional types of "click action" can be defined. In one example, sales-oriented ad objectives would include a click action screen that enabled the advertiser to specify an online coupon for a discount on the advertised service or offering. Upon a click onto the online ad, the online coupon would be displayed in a pop-up window that would enable the user to print the online coupon. In one embodiment, the click action screen would prompt the user for the content of the coupon (e.g., value of the coupon). This content data would be used to generate an online coupon that was consistent in style and presentation with the generated online ad. " The preceding text excerpt clearly indicates that pop-up information boxes may include a request for user action (e.g. prompt the user for content).) (Paragraph 139).

It would have been obvious to one skilled in the art to modify the teachings of Musgrove in view of Mathur in view of Brandli with the teachings of Cantrell to include the insert comprises a request for a user to perform an action with the motivation of defining additional types of 'click action' for online interaction (Cantrell, Paragraph 139).

As per Claims 97, Musgrove in view of Mathur in view of Brandli fail to disclose the action to be performed by the user is an action to be performed on the article.

Cantrell discloses the action to be performed by the user is an action to be performed on the article (i.e. "As can be appreciated, additional types of "click action" can be defined. In one example, sales-oriented ad objectives would include a click action screen that enabled the advertiser to specify an online coupon for a discount on the advertised service or offering. Upon a click onto the online ad, the online coupon would be displayed in a pop-up window that would enable the user to print the online coupon. In one embodiment, the click action screen would prompt the user for the content of the coupon (e.g., value of the coupon). This content data would be used to generate an online coupon that was consistent in style and presentation with the generated online ad. " The preceding text

excerpt clearly indicates that pop-up information boxes may include a request for user action (e.g. prompt the user for content).) (Paragraph 139).

It would have been obvious to one skilled in the art to modify the teachings of Musgrove in view of Mathur in view of Brandli with the teachings of Cantrell to include the action to be performed by the user is an action to be performed on the article with the motivation of defining additional types of 'click action' for online interaction (Cantrell, Paragraph 139).

As per Claims 98, Musgrove in view of Mathur in view of Brandli fail to disclose the action to be performed by the user is to provide an instruction related to the article.

Cantrell discloses the action to be performed by the user is to provide an instruction related to the article (i.e. *"As can be appreciated, additional types of "click action" can be defined. In one example, sales-oriented ad objectives would include a click action screen that enabled the advertiser to specify an online coupon for a discount on the advertised service or offering. Upon a click onto the online ad, the online coupon would be displayed in a pop-up window that would enable the user to print the online coupon. In one embodiment, the click action screen would prompt the user for the content of the coupon (e.g., value of the coupon). This content data would be used to generate an online coupon that was consistent in style and presentation with the generated online ad."* The preceding text excerpt clearly indicates that pop-up information boxes may include instruction related to the article (e.g. prompt the user for content based on instruction).) (Paragraph 139).

It would have been obvious to one skilled in the art to modify the teachings of Musgrove in view of Mathur in view of Brandli with the teachings of Cantrell to include the action to be performed by the user is to provide an instruction related to the article

with the motivation of defining additional types of 'click action' for online interaction (Cantrell, Paragraph 139).

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Hicks whose telephone number is (571) 272-2670. The examiner can normally be reached on Monday - Friday 8:30a - 5:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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